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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ODLAND, DAVID E

ART UNIT	PAPER NUMBER
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2662

DATE MAILED: 01/02/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,675

Applicant(s)

HAGEBARTH, FRANK

Examiner

David Odland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 & 8-16 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because all of the elements are shown merely as boxes with numeric references. It is suggested by the Examiner that the drawings be relabeled with descriptive terms in order to more clearly and easily portray the invention. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to because it does not include proper section headings that demark the different segments of the application. Below is a listing of the sections of the specification and what they should include (where applicable):

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.

Accomplishment

- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claim Objections

Claim 6 is objected to because the claim recites "...the respective other VoIP adapter unit..." in lines 43 and 44. To clarify the claim, this limitation should be reworded to indicate that the VoIP server sends the first VoIP adapter the address of the second VoIP address and VoIP server sends the second VoIP adapter the address of the first VoIP adapter.

Claims 4-7 and 11 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from any other multiple dependent claim (See MPEP § 608.01(n)). Accordingly, the claims have not been further treated on the merits.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 16 are rejected because it is unclear whether they are dependent or independent claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by McMullin (USPN 5,809,128), hereafter referred to as McMullin.

Referring to claim 1-5, McMullin discloses a method of activating an inactive terminal a data network characterized by the following steps: establishing a connection to a server of the data network (a caller, wishing to call a network subscriber, establishes a connection from the callers terminal to a proxy (see items 44a and 38 of figure 38)) and transmitting an identifier of the terminal to be activated to the server of the data network (the subscribers number is sent to the proxy (see figures 2 and 3)), receiving the identifier at the server of the data network (the

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proxy receives the subscribers number (see figures 2 and 3)), interpreting the identifier at the server of the data network to determine the number of the terminal to be activated (the proxy performs a DNIS lookup, thus it has interpreted the number it receives from the caller (see figures 2 and 3)); making a call from the server of the data network through the telephone network to the terminal to be activated (the server calls the subscriber through the PSTN (see figures 2 and 3)), signaling the identity of the server of the data network (the proxy communicates to the subscribers computer using IP packets which have source addresses (see figure and column 6)), receiving the call and interpreting the signaling at the terminal to be activated (the subscriber receives a notification from the proxy (see figure 2 and columns 10 and 11)), terminating the call to the terminal by the server of the data network (the proxy sends the notifications to the subscriber (see figure 2 and columns 10 and 11)) and establishing a connection from the terminal to be activated to the data network if the signaling indicates that the call came from a server of the data network (the subscriber is notified of the incoming call from the server and the subscriber can accept the call and establish communication with the caller through the use of the subscribers PC (see figure 2 and columns 10 and 11);

the establishment of the connection to the server of the data network and the transmission of the identifier of the terminal to be activated to the server of the data network are effected by the further terminal (the caller makes a call to the subscriber using the subscribers phone number (see figure 2 and column 6));

in order to establish a connection between the further terminal and the terminal to be activated, the terminal to be activated establishes a connection to a server of the data network (when the subscriber decides to communicate with the caller the subscriber indicates so to the

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proxy (see figure 2 and columns 10 and 11)) and transmits its identifier to the server or the identifier is determined by the server (the subscriber transmits IP packets to the proxy which have source addresses in them (see figure 2 and columns 10 and 11)), the data network addresses of the two terminals are transmitted by the server of the data network to the respective other terminal or are retrieved by the terminals from the server (IP packets have both source and destination addresses in them (see figure 2 and columns 10 and 11)), and connection is established by the terminals through the telephone network and the data network (a connection between the subscriber and the caller is established (see columns 10 and 11));

the data network is designed as an Internet Protocol network (the data network is an the Internet (see column 6));

the further terminal is a calling party's terminal connected to telephone network (the caller has a terminal connected to the PSTN (see figure 2)) and in that the terminal to be activated is a called party's terminal connected to the telephone network (the subscribers computer is connected to the PSTN (see figure 2)) the called party's terminal being activated to set up a voice call between the calling party's terminal and the called party's terminal through the IP network (the subscriber sets up a connection with the caller through the Internet (see figure 2 and columns 10 and 11)).

Referring to claim 8-11, McMullin discloses a server of a data network (a proxy server of a data network (see figure 2)), characterized by means for receiving from a terminal an identifier of a terminal to be activated, which connected to a telephone network (the proxy receives a phone number of a subscriber connected to the PSTN and to whom a caller wishes to contact (see figure 2 and column 6)) means for making a call over the telephone network to the terminal

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to be activated (the proxy contacts the subscriber through the PSTN (see figure 2)) and means for terminating the call to the terminal to be activated (the proxy can terminate the call by the caller in various ways, such as voice mail functions (see figure 2 and columns 10 and 11));

the server is designed as an access server in an IP network (the proxy can be implemented in the Internet and serves to provide access to a subscriber by the caller (see figure 2 and columns 10 and 11));

the server characterized by comprising means for interpreting the identifier and determining the number of the terminal to be activated (the proxy interprets the subscribers number entered by the caller in order to perform a look-up function (see figure 3));

the server characterized in that it comprises means for accepting a call received from the terminal over the telephone network and means for establishing a connection from the terminal the data network (the proxy comprises means for implementing calls from the subscriber to the caller that traverse through the PSTN and Internet (see figure 2 and columns 10 and 11)).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-16, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullin in view of Crichton et al. (USPN 6,104,716), hereafter referred to as Crichton.

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Referring to claim 12,15 and 16, McMullin discloses an adapter unit characterized by means for establishing a connection from the terminal to a server of a data network over the telephone network (the subscriber using his or her computer can establish a connection to the proxy through the PSTN (see figure 2 and columns 10 and 11)), means for receiving the call of a server of the data network (the proxy connects a call with the subscribers computer (see figure 2 and columns 10 and 11)), means for interpreting the number of a caller (the callers number is displayed to the subscriber by the subscribers computer (see figure 2 and columns 10 and 11)), means for retrieving and/or receiving a data network address of a further adapter unit of the caller from the server of the data network (the proxy sends the subscriber the phone number of the caller (see figure 2 and columns 10 and 11)) and means for establishing a data call to the further adapter unit through the data network (the subscriber uses his or her computer to establish a call with the caller (see figure 2 and columns 2 and 3)).

McMullin does not disclose that system also comprises means for comparing the number of the caller with the numbers of known servers of the data network. However, Crichton discloses a system wherein a computer system that uses a firewall to compare the addresses of incoming packets received from a server in order to verify that the server is known and trusted (see figure 4 and column 4)). It would have been obvious to one skilled in the art at the time of the invention to implement this feature in the McMullin system because doing so would make McMullin more safe and secure.

Referring to claims 13 and 14, McMullin discloses the system discussed above. Furthermore, McMullin discloses means for transmitting the identifier of a terminal to be activated or the identification of a called party to the server of the data network (the caller sends

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the phone number of the subscriber he or she is trying to call to the proxy and also the subscriber, when he or she decides to communicate with the caller through the computer, sends the callers address to the proxy in an IP packet so that the proxy knows where to send the packet when it is received (see figure 2 and columns 10 and 11));

characterized by being implemented as a processor, a memory, an interface to the telephone network, and an interface to an Internet Protocol (IP) network (the subscribers computer has a processor, a memory and interfaces to the PSTN and Internet (see figure 2 and columns 10 and 11)).

Conclusion

9. The following prior art, which is made of record and not relied upon, is considered pertinent to applicant's disclosure:

- a. U.S. Patent Number 6,661,785 to Zhang et al.
- b. U.S. Patent Number 6,065,118 to Bull et al.
- c. U.S. Patent Number 5,566,163 to Petit et al

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Odland, who can be reached at (703) 305-3231 on Monday – Friday during the hours of 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou, can be reached at (703) 305-4744. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, who can be reached at (703) 305-4750.

deo

December 28, 2003



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